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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

EINSMANN, MARGARET V

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 04/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

C1

Office Action Summary	Application No. 10/749,166	Applicant(s) SZYMANSKI, MATTHEW A.	
	Examiner Margaret Einsmann	Art Unit 1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17, 20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Applicant's election of Group I, claims 1-17 in the reply filed on 9/21/05 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

This application contains claim s 18 and 19awn to an invention nonelected with traverse. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claims 1-17, 20 and 21 are being examined in this action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

The rejection of Claims 1-6,12-14,16 and 17 under 35 U.S.C. 102(b) as being anticipated by Cabot Corporation, WO 99/23179 has been mooted by applicant's amendments.

Claims 1-5, 9,10, 12-14,16,17 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Clark et al., US RE. 24,554.

Example 1 and 2 in columns 3 and 4. disclose paper (a cellulosic substrate) which has been dyed with a colorant composition comprising a pigment, thickener and a solvent and then coated with an overcoating. Regarding claim 3, the colorant in both examples are provided as dispersions, indicating that the colorants are in the form of particles and thus were provided in the form of dry coloring matter, meeting the limitation claim 3. Regarding claim 4, the rubber which acts as thickener is provided in amounts of approximately 1% in example 1 and approximately 3% in example 2. The

pigment is present in examples 1 and 2 in an amount of about 17%, meeting the limitations of claims 9 and 10. The overcoat comprises latex crepe rubber meeting the limitations of claims 12 and 14. Regarding claims 16 and 17, the coatings are applied by means of a spreader knife or bar. In the examples described above, the overcoat comprises a latex rubber. However, in example 15 in col 13, the colored paper may also be coated with a treating composition comprising a methyl methacrylate polymer, meeting the limitation of claim 13.

Accordingly all of the material limitations of the claims are met.

Response to Arguments and Amendments

Applicant's arguments filed 2/3/2006 have been fully considered but they are not persuasive. Accordingly the rejection is maintained and also applied to newly added claim 20. Applicant states that the claim amendment excludes the process of Clark because the claims exclude the application of two different colorants to the paper. Clark provides a cellulosic substrate as claimed, provides a colorant to the substrate, consisting essentially of a non-white pigment, a thickener and a solvent, and then applies an overcoat to the colorant. While it is true that Clark's overcoat comprises a colorant, said colorant in the coating is not excluded by the claim language. Accordingly the rejection is maintained.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark et al. Clark is applied as set forth in the above rejection as teaching a method of applying a thickened colorant solution to paper and then applying an overcoat. In the examples described above, the application rate of the colorant composition or overcoat is described in terms of the thickness of the applied coating and not in terms of the weight of the substrate as claimed. It would have been obvious to the man having skill in the art at the time the invention was made to adjust the coating thickness so that the paper is not overloaded and still is useful for his intended purpose, and it is seen that the spreader knife or bar used in the examples is readily adjustable to provide any coating weight needed. See example 1 wherein the coating layers are applied at various thicknesses. (col 3 lines 50 and 58).

Response to Arguments and Amendments

Applicant's arguments filed 2/3/2006 have been fully considered but they are not persuasive regarding the above rejection. Applicant argues that the amendments to claim 1 rule out the Clark reference. Applicant respectfully disagrees. See arguments above regarding the 102 rejection of claim 1 over Clark.

Claims 1-3,5-8 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over The Dow Chemical Company, EP 1,176,255 A1.

Dow discloses a pigmented coating composition comprising a starch dispersion as binder which is used as a coating color for paper. See abstract. Table 1 on page 7 shows an aqueous precoat formulation comprising calcium carbonate pigment, latex, two different starches and CMC as binders (thickeners). See also claim 1 on page 10. the reference differs from the claims in that there is no showing of the application of said pigmented coating composition comprising starch to paper or paperboard and then applying an overcoat as claimed. It would have been obvious to the man having skill in the art of papermaking to apply an overcoat as claimed to the color coated papers of Dow because Dow states that the coating compositions of Table 1 are precoat compositions which is a teaching that at least one overcoating will be applied.

Response to Arguments and Amendments

Applicant's arguments filed 2/3/2006 have been fully considered but they are not persuasive regarding the above rejection. Accordingly the rejection is maintained. Applicant argues that the EP reference does not teach the step of applying a colorant consisting essentially of a non-white pigment, a binder and solvent to the cellulosic substrate. The examiner respectfully disagrees with this analysis of the reference. In claim 1 patentee discloses that the composition may comprise "pigments". The examiner does not see any indication that non-white pigments are excluded. In the listing of pigments, clay, for example, includes non-white clays, and the polymer particles include translucent, or colorless pigments.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 21 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. There is no description of any dye within the scope of the formula presented in claim 21 critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Applicant provides a general formula but does show even one instance of a dye included in the formula in claim 21. There is no indication that applicant had in his possession at the time the invention was made, the claimed process wherein even one dye within the scope of the claimed formula was used. For the description to be enabling there needs to be a teaching of which dyes fall within the general formula, a listing or Color Index names or numbers, a method of formulating the dyes, or some other indication of dyes falling within the scope of the formula, and a description or example of using at least one dye falling within the scope of the claimed formula.

Claims 1-17, 20 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no basis in the originally

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filed specification for the "non-white pigment" as now claimed. Applicant points to page 4 lines 4-8 which states that the dyestuff or pigment is defined as a compound within the class of other basic dyes or anionic direct dyes or fiber reactive dyes, or a pigment which can impart color to a cellulosic material such as dry coloring matter. The examiner does not see how this becomes the basis for "non-white pigment" The term excludes white pigments. The examiner sees no teaching of white pigments in the above section of the reference. Applicant cannot exclude anything that is not in the originally filed specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In the first place, a pigment is not a dye, though they are both colorants. See specification at page 4 line 4 "dyestuff or pigment" or page 1 line 27 "dyestuff **and/or** pigment" Accordingly the dye of claim 21 does not further limit the "non-white pigment" of claim 20.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret Einsmann whose telephone number is 571-272-1314. The examiner can normally be reached on 7:00 AM -4:30 PM M-W and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on 571-272-1029. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thursday, April 06, 2006


Margaret Einsmann
Primary Examiner
Art Unit 1751